

**REMARKS**

This Amendment and Response is in response to the Office Action, dated July 31, 2002, where the Examiner has rejected claims 1, 8-10, 19-20, 32-33, 40-42, 44-45, 47-48, 54-56, 63-66 and 68-84. By the present amendment, applicants have cancelled claims 1, 8-10, 19-20, 47-48, 63-66, 68-69 and 71-72, and amended claims 44, 73 and 79. After the present amendment, claims 32-33, 40-42, 44-45, 54-56, 70, 73-84 are pending in the application.

Applicants would like to express their gratitude for the Examiner's courteous interview conducted with the undersigned today. In accordance with the discussions with the Examiner, in order to avoid a restriction/election office action, applicants have cancelled claims 1, 8-10, 19-20, 32-33, 40-42, 44-45, 54-56, 63-66 and 68-84. In light of the clarifications made to distinguish the pending claims over the cited references, as set forth in responses to previous office actions, applicants respectfully request allowance of pending claims 32-33, 40-42, 44-45, 54-56, 70, 73-84.

**A. Rejection of Claims 32-33, 40-42, 44-45, 54-56, 70 and 73-84 under 35 U.S.C. § 103(a)**

The Examiner has rejected claims 32-33, 40-42, 44-45, 54-56, 70 and 73-84 under 35 U.S.C. § 103(a) as being unpatentable over Civanlar, et al. (EP 0741481 A2) in view of Armstrong (US 3,626,107.) Applicants respectfully disagree.

Neither Civanlar nor Armstrong comes close to teaching, suggesting or disclosing, in combination or otherwise, claim 32 of the present application. The Examiner states:

Civanlar differs from the claimed invention in not specifically teaching said handset placed off-hook by a user for dialing an outgoing call. However, Armstrong teaches three way calling and call-waiting arrangement for telephone system for providing dial tone to a user for dialing an outgoing call when hook-switch is detected. (Office Action, page 6.)

Applicants strongly disagree with the Examiner's rejection based on Civanlar and Armstrong. Armstrong merely teaches a relay setup for call-waiting and three way calling, and it fails to disclose, teach or suggest "an off-hook detector" and also that the off-hook detector is "capable of generating an attention signal" in response to the handset going off-hook. Further, there is no teaching or suggestion in Civanlar that the communication can be interrupted for any reason but the call-waiting signal. Accordingly, applicants disagree with the Examiner's position in rejecting claim 32, and respectfully request that claim 32 and its dependent claims 33, 40-42 and 70 be allowed.

Moreover, claim 44 and its respective dependent claims 44-45 and 54-56 should be allowed at least for the same reasons stated in conjunction with claim 32.

The Examiner has also rejected claim 73 stating that:

Civanlar differs from the claimed invention in not specifically teaching to provide a new communication channel for connecting telephone device A and telephone device C. However, Armstrong teaches such .... (Office Action, pages 8-9.)

Applicants respectfully disagree with the Examiner's position. As stated above, Armstrong, filed in 1969, merely teaches a relay setup for call-waiting and three way calling; however, it fails to disclose, teach or suggest that the "modem causes a dial tone to be generated over said telephone line after said communication between said modems is placed on hold", as recited in claim 73. There is also no teaching or suggestion in Civanlar that after the modem communication is placed on hold, dial tone can be generated. In fact, Civanlar teaches away from generating a dial tone, since answering a call-waiting causes a new communication to be established without a need for dialing a number.

Applicants would like to point out that, as stated by the Federal Circuit in **In re Gordon**, 733 F.2d 900, 902 (Fed. Cir. 1984) (see also **In re Fitch**, 972 F.2d 1260 (Fed. Cir. 1992)):

“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification” (emphasis added).

Similarly, as stated by the Federal Circuit in **In re Chu**, 66 F.3d 292, 298 (Fed. Cir. 1995):

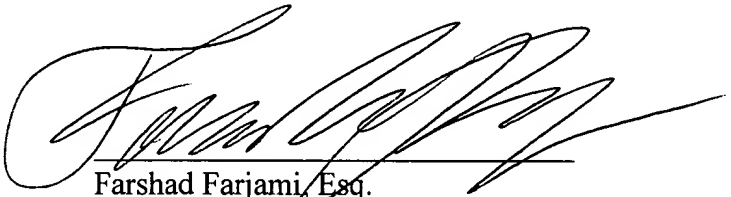
In a proper obviousness determination, "whether the changes from the prior art are 'minor', ... the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee's ... device." (citations omitted.) This includes what could be characterized as simple changes, as in *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984) (**Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down**). (emphasis added.)

Accordingly, applicants respectfully submit that claim 73 and its dependent claims 74-78 should be allowed. In addition, claim 79 and its dependent claims 80-84 should be allowed at least for the same reasons stated in conjunction with claim 73.

**B. Conclusion**

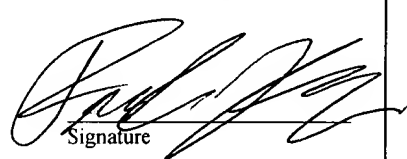
For all the foregoing reasons, an early allowance and issuance of claims 32-33, 40-42, 44-45, 54-56, 70, 73-84 pending in the present application is respectfully requested. The Examiner is invited to contact the undersigned for any questions.

Respectfully Submitted;  
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I hereby certify that this correspondence is being transmitted via facsimile to: (703) 872-9314, Assistant Commissioner for Patents, Washington, D.C. 20231, on <u>10/31/02</u>	
NAME <u>FARSHAD FARJAMI</u>	SIGNATURE 

**Marked-Up Version of the Amended Claims**

44. (Thrice Amended) A communication method for use between a first device and a second device in communication over a communication channel, said first device being in communication with a handset, said communication method comprising the steps of:

detecting said handset going off-hook;

transmitting a hold request to said second device in response to said handset going off-hook;

ceasing said communication with said second device over said communication channel by said first device for a period of time; and

causing a dial tone to be generated for dialing an outgoing call using said handset.

73. (Amended) A first modem capable of communicating with a second modem over a communication channel, a portion of said communication channel existing over a telephone line between said first modem a central office, said first modem comprising:

a receiver capable of receiving a relinquishment request, while said telephone line is in use by said first modem for communication with said second modem, to relinquish said use of said telephone line; and

a transmitter capable of transmitting a hold request to said second modem to place said communication between said modems on hold;

wherein said communication between said modems is placed on hold and said use of said telephone line is relinquished, and wherein said first modem causes a dial tone is to be generated ~~received~~ over said telephone line after said communication between said modems is placed on hold.

79. (Amended) A method of sharing a telephone line by a first modem capable of communicating with a second modem over a communication channel, a portion of said communication channel existing over said telephone line between said first modem a central office, said method comprising:

receiving a relinquishment request, while said telephone line is in use by said first modem for communication with said second modem, to relinquish said use of said telephone line; ~~and~~

transmitting a hold request to said second modem to place said communication between said modems on hold;

placing said communication between said modems on hold;

relinquishing said use of said telephone line; and

causing receiving a dial tone to be generated over said telephone line.